UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,870	12/29/2003	Jeffrey A. Dean	Google-35APP (GP-090-00-U	3713

82402 7590 07/21/2009

Straub & Pokotylo
788 Shrewsbury Avenue
Tinton Falls, NJ 07724

EXAMINER	
TSUI, WILSON W	

ART UNIT	PAPER NUMBER
2178	

MAIL DATE	DELIVERY MODE
07/21/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/748,870	DEAN ET AL.	
	Examiner	Art Unit	
	WILSON TSUI	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 May 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20080307,20090513*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This non-final action is in response to the RCE filed on: 05/13/09, IDS filed on: 03/07/09, and 05/13/09.

2. Claims 1-20 are pending. Claims 1, 7, 9, and 15 are independent claims.

3. The following rejections are withdrawn, in view of new grounds of rejection based upon new art/key-words searched with the help of applicant's submitted IDS entries:

- Claims 7, 15, and 20 rejected under 35 U.S.C. 102(b) as being anticipated by Graham et al.
- Claims 1 and 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al.
- Claims 2, 10, and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al in further view of Bhagavath et al and ProductReview.
- Claims 3, 8, 11, 16, and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al in further view of Bhagavath et al and CNET.
- Claims 4, 12, and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al and Bhagavath et al in further view of MSN.
- Claims 5 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al in further view of Bowman et al.
- Claims 6 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al in further view of Weaver.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 03/07/09, and 05/13/09 are being considered by the examiner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With regards to claim 1, the claimed method does not appear to be tied to a particular machine or apparatus. See In re Bilski, 545 F.3d943, 88 USPQ2d 1385 (Fed. Cir. 2008).

With regards to claims 2-6, since they do not resolve the deficiencies, explained in the 35 U.S.C. 101 rejection for claim 1; they are rejected under similar rationale as claim 1.

With regards to claim 7, the claimed method does not appear to be tied to a particular machine or apparatus. See In re Bilski, 545 F.3d943, 88 USPQ2d 1385 (Fed. Cir. 2008).

With regards to claim 8, since the claim does not resolve the deficiencies of claim 7; it is rejected under similar rationale as claim 7.

With regards to claim 9, the claimed “apparatus” appears to be a "computer program per se" without hardware. Thus since the computer program is not stored in a computer readable medium, it is not statutory. See MPEP 2106 below:

> Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure
> defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory

With regards to claims 10-14, they do not remedy the deficiencies of claim 9 as similarly explained above, and thus, are rejected under similar rationale.

With regards to claim 15, the claimed “apparatus” appears to be a "computer program per se" without hardware. Thus since the computer program is not stored in a computer readable medium, it is not statutory. See MPEP 2106.

With regards to claim 16, since it does not remedy the deficiencies of claim 15, as similarly explained above; it is rejected under similar rationale.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 7, 9, 15, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Barry et al (US Application: 2004/0015397 A1, published: Jan. 22, 2004, filed: Dec. 4, 2002, EEFD: Jul. 16, 2002).

With regards to claim 1, Barry et al teaches a method comprising:

a) *Accepting ad document information* (Fig 15, paragraph 0064: whereas, an advertisement is accepted as one of the highest bidders for a particular level of content)

b) Using the ad document information to determine content in addition to content of the ad document (Fig 15, paragraph 0064: whereas, noting the highest bidder for the ad document information, selecting a second highest bidder for a particular level of content)*; and*

c) combining at least a portion of content of the ad document and at least a portion of the determined content for presentation to a user together with page content, wherein the ad document is at least one ad, and wherein the page content is not directly used to determine the determined content (Fig 15, paragraph 0064: whereas, the node level of content, and amount of payment for an advertisement is used to determine the additional content, such that the content of the ad document having the highest bidder, the content of the additional content having the second highest bidder, and the content of the page residing at the particular level of content are combined together).

With regards to claim 7, Barry et al teaches a method comprising:

a) accepting document information (Fig 15, paragraph 0064: whereas, a web page having a particular level of content based upon node is accepted)

b) using the document information to determine content in addition to content of the document (whereas the document information (Fig 15, paragraph 0064: which includes document, and the node level of content) is used to determine content (such as an advertisement for the highest bidder))

c) using the determined content, determining further content (Fig 15, paragraph 0064: whereas, noting the highest bidder for the ad document information, selecting a second highest bidder as further content)*; and*

d) combining at least a portion of content of the document, at least a portion of the determined content, and at least a portion of the determined further content for presentation to a user (Fig 15, paragraph 0064: whereas, the determined content, the

further determined content, and the content of the page residing at the particular level of content are combined together).

With regards to claim 9, Barry et al teaches an apparatus comprising:

a) an input for accepting ad document information (Fig 15, paragraph 0064: whereas, an advertisement is accepted as one of the highest bidders for a particular level of content)*;*

b) means for determining content in addition to content of the ad document using the ad document information (Fig 15, paragraph 0064: whereas, noting the highest bidder for the ad document information, selecting a second highest bidder for a particular level of content)*; and*

c) means for combining at least a portion of content of the document and at least a portion of the determined content for presentation to a user together with page content, wherein the ad document is at least one ad, and wherein the page content is not directly used to determine the determined content (Fig 15, paragraph 0064: whereas, the node level of content, and amount of payment for an advertisement is used to determine the additional content, such that the content of the ad document having the highest bidder, the content of the additional content having the second highest bidder, and the content of the page residing at the particular level of content are combined together).

With regards to claim 15, Barry et al teaches an apparatus comprising:

a) an input for accepting document information (Fig 15, paragraph 0064: whereas, a web page having a particular level of content based upon node is accepted)*;*

b) means for determining content in addition to content of the document using the document information (Fig 15, paragraph 0064: which includes document, and the node level of content) is used to determine content (such as an advertisement for the highest bidder))*;*

c) means for determining further content using the determined content (Fig 15, paragraph 0064: whereas, noting the highest bidder for the ad document information, selecting a second highest bidder as further content)*; and*

d) means for combining at least a portion of content of the document, at least a portion of the determined content, and at least a portion of the determined further content for presentation to a user (Fig 15, paragraph 0064: whereas, the determined content, the further determined content, and the content of the page residing at the particular level of content are combined together).

With regards to claim 20, which depends on claim 7, Barry et al teaches *wherein the acts of (b) using the document information to determine content in addition to content of the document,* (c) using the determined content, determining further content, and (d) combining at least a portion of content of the document, at least a portion of the determined content, and at least a portion of the determined further content for presentation to a user (as similarly explained in the rejection for claim 7), are performed

automatically by a machine executing machine-executable instructions (page 8, claim 10 of Barry et al: whereas a system comprising a storage, is used execute steps).

7. Claims 2, 10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barry et al (US Application: 2004/0015397 A1, published: Jan. 22, 2004, filed: Dec. 4, 2002, EEFD: Jul. 16, 2002), in further view of ProductReview (Edmunds.com, Page 1, Jan. 22, 2001).

With regards to claim 2, which depends on claim 1, Barry et al teaches a method comprising:

- *The at least one ad*, in claim 1, and is rejected under the same rationale.
- *The determined content*, in claim 1, and is rejected under the same rationale.
- An ad database, which stores advertisement listings (page 8, claim 10 of Barry et al), and an *ad is for a product* (Fig 15: whereas a breast pump product is shown).

However, although Barry et al teaches that an additional ad, can be of a particular subject matter (paragraph 0004: whereas advertisements are selected based on subject matter), Barry et al does not expressly show that the determined content is *a review for the product*.

ProductReview teaches the *at least one ad is for a product and wherein the determined content is a review for the product* (page 1: whereas, a car is the product,

and through inherent display constraints, only additional content concerning a review of the particular car is displayed on the right hand side of the page).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Barry et al's method for displaying advertisements of of particular subject matter, to have further included an advertisement for determined content to be a review for a product, as taught by ProductReview. The combination of Barry et al, and ProductReview, would have allowed Barry et al's system to have been able to provide product review information when the ad is a product.

With regards to claim 10, which is dependent on claim 9, for an apparatus performing a similar method to claim 2, is rejected under the same rationale.
With regards to claim 17, which depends on claim 2, Barry et al teaches *wherein the acts of (b) using the ad document information to determine content in addition to content of the ad document, and (c) combining at least a portion of content of the ad document and at least a portion of the determined content for presentation to a user together with page content* (as similarly explained in the rejection for claim 1)*, are performed automatically by a machine executing machine-executable instructions* (page 8, claim 10 of Barry et al: whereas a system comprising a storage, is used execute steps).

8. Claims 3, 8, 11, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barry et al (US Application: 2004/0015397 A1, published: Jan. 22,

2004, filed: Dec. 4, 2002, EEFD: Jul. 16, 2002), in further view of CNET (CNET.COM, page 1, December 7, 2001).

With regards to claim 3, which depends on claim 1, Graham et al teaches a method comprising:

- *The at least one ad*, in claim 1, and is rejected under the same rationale.
- *The determined content*, in claim 1, and is rejected under the same rationale.
- An ad database, which stores advertisement listings (page 8, claim 10 of Barry et al), and an *ad is for a service* (Abstract: whereas audiences can be interested in service advertisements).

However, Barry et al does not expressly teach that the determined content *is a review for the service.*

Yet, CNET teaches at least one ad *is for a service and wherein* the determined content *is a review for the service* (page 1: whereas, 'PC Connection' is the name of the service, and the review is indicated by a "star" ranking system).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Barry et al's method for displaying advertisements of a particular subject matter, to have further included an advertisement for determined content to be a review for a service, when a service was being browsed, as taught by CNET. The combination of Barry et al and CNET, would have allowed Barry et al's

system to have been able to have provided service review information when the ad was a service.

With regards to claim 8, which depends on claim 7, Barry et al and CNET teach *wherein the determined content is one of a review*, in claim 3, and is rejected under the same rationale.

Furthermore, Barry et et al teaches *wherein the further determined content is at least one ad relevant to the determined content* (as similarly explained in the rejection for claim 7, since the advertisements are selected based upon several factors included a particular content level).

With regards to claim 11, which depends on claim 9, for an apparatus performing a method similar to claim 3, is rejected under the same rationale.

With regards to claim 16, which depends on claim 15, for an apparatus performing a similar method to the method in claim 8, is rejected under the same rationale.

With regards to claim 18, which depends on claim 3, Barry et al teaches *wherein the acts of (b) using the ad document information to determine content in addition to content of the ad document, and (c) combining at least a portion of content of the ad document and at least a portion of the determined content for presentation to a user*

together with page content (as similarly explained in the rejection for claim 1)*, are performed automatically by a machine executing machine-executable instructions* (page 8, claim 10 of Barry et al: whereas a system comprising a storage, is used execute steps).

9. Claims 4, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barry et al (US Application: 2004/0015397 A1, published: Jan. 22, 2004, filed: Dec. 4, 2002, EEFD: Jul. 16, 2002), in further view of MSN (MSN.COM, page 1, Dec. 7, 2000).

With regards to claim 4, which depends on claim 1, Barry et al teaches a method comprising:

- *The at least one ad*, in claim 1, and is rejected under the same rationale.
- *The determined content*, in claim 1, and is rejected under the same rationale.
- An ad database, which stores advertisement listings (page 8, claim 10 of Barry et al), and an *ad is for a service* (Abstract: whereas audiences can be interested in service advertisements).

However, Barry et al does not expressly teach *wherein* the determined content *is a news story about the product or service*.

Yet, MSN teaches at least one ad *is for a product or service and wherein* the determined content *is a news story about the product or service* (MSN, page 1:

whereas, MSN Messenger is the service, and news about MSN Messenger is provided as additional content).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Barry et al's method for displaying advertisements of a particular subject matter, to have further included an advertisement for determined content to display a news story about a service as taught by MSN. The combination of Barry et al and MSN, would have allowed Barry et al's system to have been able to have provided service news information when the ad was a service type.

With regards to claim 12, which is depends on claim 9, for an apparatus performing a method similar to claim 4, is rejected under the same rationale.

With regards to claim 19, which depends on claim 4, wherein the acts of (b) using the ad document information to determine content in addition to content of the ad document, and (c) combining at least a portion of content of the ad document and at least a portion of the determined content of presentation to a user together with page content (as similarly explained in the rejection for claim 1), are performed automatically by a machine executing machine-executable instructions (page 8, claim 10 of Barry et al: whereas a system comprising a storage, is used execute steps).

10. Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barry et al (US Application: 2004/0015397 A1, published: Jan. 22, 2004, filed: Dec. 4,

2002, EEFD: Jul. 16, 2002), in further view of Bowman et al (US Patent: 6,006,225, published: Dec. 21, 1999, filed: Sep. 1, 1998).

With regards to claim 5, which depends on claim 1, Barry et al teaches a method comprising t*he determined content*, in claim 1, and is rejected under the same rationale.

However, Barry et al does not teach the determined content *is a search query related to the document.*

Bowman et al teaches the determined content *is a search query related to the document* (column 1, lines 55-67, Fig. 9: whereas, based on the contents of a document, a suggested query is presented to the user).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Barry et al's system for determining content to have also included Bowman et al's system for suggesting a query based on document content. The combination would have allowed Barry et al's system to have been able to "efficiently locate the most relevant terms" (Bowman et al, column 2, lines 23-24).

With regards to claim 13, for an apparatus performing a similar method as in claim 5, is rejected under the same rationale.

11. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barry et al (US Application: 2004/0015397 A1, published: Jan. 22, 2004, filed: Dec. 4,

2002, EEFD: Jul. 16, 2002), in further view of Weaver (US Application: US 2004/0093558 A1, published: May 13, 2004, filed: Oct. 29, 2003, EEFD: Oct 29, 2002).

With regards to claim 6, which depends on claim 1, Graham et al teaches a method comprising *the determined content*, in claim 1, and is rejected under the same rationale. Furthermore, Barry et al teaches determining the content by going through an advertisement database for related content level, as explained in claim 1. However, Graham et al does not teach the determined content *is a message from a user group.*

Weaver teaches a message database that stores *messages from a user group* (claim 2).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Barry et al's advertisement database, which associated advertisements associated with a particular content-level/concepts; to a database that stored messages (as taught by Weaver) which associated messages with concepts. The combination would have allowed Barry et al's system to have been able to determine the most appropriate user group message based on the document content.

With regards to claim 14, which depends on claim 9, for an apparatus performing a similar method to claim 6, is rejected under the same rationale.

Response to Arguments

12. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILSON TSUI whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CESAR B PAULA/
Primary Examiner, Art Unit 2178

/Wilson Tsui/
Patent Examiner

Art Unit: 2178
July 19, 2009